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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 06502.0369

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on _____

Signature _____

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Application Number	Filed
10/035,587	12/28/2001

First Named Inventor: Guy L. Steele, JR.

Art Unit	Examiner
2193	Tan V. Mai

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☒ attorney or agent of record. Registration number 56,249
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Nathan A Sloan
Signature

Nathan A. Sloan
Typed or printed name

202.408.4312
Telephone number

9/30/05
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of 1 forms are submitted.

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EXPEDITED PROCEDURE REQUESTED
EXAMINING GROUP 2193
PATENT
Customer No. 22,852
Attorney Docket No. 06502.0369-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Guy L. STEELE, Jr.	)	Group Art Unit: 2193
	)	
Application No.: 10/035,587	)	Examiner: Mai, Tan V.
	)	
Filed: December 28, 2001	)	Confirmation No.: 2874
	)	
For: FLOATING POINT STATUS INFORMATION ACCUMULATION CIRCUIT	)	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal brief review of the rejections in the Office Actions mailed on October 22, 2004 and June 3, 2005. This Request is being filed concurrently with a Notice of Appeal, in accordance with the Official Gazette Notice of July 12, 2005.

This Pre-Appeal Brief request for review follows the Examiner's Advisory Action mailed August 24, 2005, which merely states "[t]he Examiner believes the rejections are proper" (Advisory Action at p. 1). None of the points raised by Applicant in the Request for Reconsideration mailed August 3, 2005 (hereafter "*RFR*") have been addressed by the Examiner.

Remarks begin on page 2 of this paper.

REMARKS

Claims 1-47 remain pending, with claims 1-3 and 5-47 being the subject of this Pre-Appeal Brief request for review. In the Final Office Action, the Examiner rejected claims 1-3 and 5-47 under two separate 35 U.S.C. § 103(a) rejections: as unpatentable over U.S. Patent No. 5,995,991 to Huang et al. ("*Huang*"); and as unpatentable over U.S. Patent No. 6,009,511 to Lynch et al. ("*Lynch*").

I. The rejection of claims 1-3 and 5-47 under 35 U.S.C. § 103(a) as being unpatentable over *Huang* is improper.

The Examiner's rejection contains clear errors and omits essential elements necessary to establish a *prima facie* case of obviousness with respect to claims 1-3 and 5-47 based on *Huang*. *Huang* does not teach or suggest each and every element of Applicant's claims, and there is no motivation to modify *Huang*.

Claim 1 recites a combination including, for example, "operands ... having encoded status flag information." *Huang* does not teach or suggest this element.

The Examiner appears to assert that *Huang's* register 116 (Fig. 4) constitutes the claimed "operand." This is clearly wrong.

Huang specifically distinguishes between a register and an operand, stating "each of the **registers** 116 and 118 has an **operand . . . portion** 116-1 and 118-1." (*Huang,* col. 6, line 66- col. 7, line 1). Moreover, "**operands** X and Y [are] stored in **operand portions** 116-1 and 118-1 of **registers** 116 and 118." (*Huang*, col. 7, lines 8-10). Even assuming that tag values x_tag and y_tag correspond to the claimed "status flag information," (which Applicant does not concede) the Examiner's contention that *Huang's* register 116 containing x_tag 116-2 constitutes the claimed "operands ... having encoded status flag information" is clearly contradicted by *Huang*. See, e.g., *RFR* at pp. 4-6.

Structures such as those taught by *Huang* were acknowledged in the Background section of Applicant's specification, which states "conditions are typically represented by flags that are stored in the floating point status register separate from the result itself" (paragraph 025, *see also* paragraph 003). Claim 1 specifically distinguishes over such structures, calling for "operands ... having encoded status flag information." See, e.g., Fig. 2, paragraph 047, and paragraph 048 of Applicant's specification.

Accordingly, the Examiner's position that *Huang's* register 116 constitutes an "operand," as recited in the claims, is a clear error. The separate operand 116-1 and separate tag value 116-2 of *Huang* do not constitute a teaching or suggestion of "operands ... having encoded status flag information," as recited by independent claims 1, 18, and 33 and required by dependent claims 2, 3, 5-17, 19-32, and 34-47. Since *Huang* fails to teach each and every element of the claims, no *prima facie* case of obviousness has been established.

Moreover, the Examiner has neither indicated how *Huang* could be modified nor provided any motivation to modify *Huang* to achieve the claimed combination (see *RFR* at p. 8 and Office Action mailed October 22, 2004 at p. 4). Therefore, no *prima facie* case of obviousness has been established for claims 1, 18, and 33. Similar arguments apply to dependent claims 3, 5-17, 19-32, and 34-47 (see *RFR* at p. 9 and Office Action mailed October 22, 2004 at p. 4).

Therefore, the rejection of claims 1-3 and 5-47 under 35 U.S.C. § 103(a) based on *Huang* is improper. Applicant requests the board of examiners to allow these claims.

II. The rejections of claims 1-3 and 5-47 under 35 U.S.C. § 103(a) as being unpatentable over *Lynch* are improper.

The Examiner's rejection contains clear errors and omits essential elements necessary to establish a *prima facie* case of obviousness with respect to Applicant's claims 1-3 and 5-47 based on *Lynch*. Similar to the discussion of *Huang* above, *Lynch* neither teaches nor suggests "operands ... having encoded status flag information," as recited by claim 1.

The rejection does not make clear what portion(s) of *Lynch* allegedly teach the claimed "status flag information." However, even assuming that *Lynch's* tag value constitutes "status flag information," (which Applicant does not concede) *Lynch* does not teach or suggest "operands ... having encoded status flag information," as recited by claim 1.

The Examiner appears to assert that *Lynch's* element 84 (Fig. 4) constitutes an "operand" which contains tag field 89 (alleged status flag information). See Office Action mailed October 22, 2004 at p. 5). This is incorrect. *Lynch* specifically states that element 84 is a register stack, not an operand, and that register stack 84 contains a separate Reg Field 87 for storing an operand and a separate Tag Field 89 for storing a tag (alleged status flag information). See *RFR* at p. 12. Fig. 4 of *Lynch* clearly illustrates that Tag Field 89 (status flag information) and Reg Field 87 (operand) are separate from each other and stored within register stack 84. This does not constitute a teaching or suggestion of "operands ... having encoded status flag information," as recited by independent claims 1, 18, and 33 and required by dependent claims 2, 3, 5-17, 19-32, and 34-47.

Moreover, the Examiner has neither indicated how *Lynch* could be modified nor provided any motivation to modify *Lynch* to achieve the claimed combination (*see RFR* at

p. 13; *see* Office Action mailed October 22, 2004 at p. 5). Therefore, no *prima facie* case of obviousness has been established for independent claims 1, 18, and 33. Similar arguments apply to dependent claims 3, 5-17, 19-32, and 34-47 (*see RFR* at p. 14 and *see* Office Action mailed October 22, 2004 at pp. 5-6).

Therefore, the rejection of claims 1-3 and 5-47 under 35 U.S.C. § 103(a) based on *Lynch* is improper. Applicant requests the board of examiners to allow these claims.

In view of the foregoing, claims 1-47 are in condition for allowance. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 30, 2005

By: Nathan A. Sloan
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